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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,669	01/23/2001	Patrice Claviez-Homberg	DATA-B0012	2836
7590 04/21/2006			EXAMINER	
William A. Drucker 1901 L Street, N.W. Suite 800 Washington, DC 20036-3506			GRAHAM, CLEMENT B	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/766,669

Applicant(s)

CLAVIEZ-HOMBERG, PATRICE

Examiner

Clement B. Graham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4 and 7-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 7-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1, 4, 7-19 remained pending and claims 2-3, 5-6 has been deleted.

#### Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4, 7-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over in Otsuka et al ( Hereinafter Otsuka U.S Patent No: 6, 529, 453) in view of Hidding U.S. Patent No. 5, 519, 624 in view of Wolf U.S. Patent No. 5, 848, 413.

As per claims 1, 16, 18-19, Otsuka discloses method for checking the use of a system for transmitting information in the form of multidimensional matrix codes, said system using a computer linked to a data base containing identification and addressing data of addressees and programmed so as to carry out the following operations; of allocating to each user an electronic circuit ("i. e, ic card" see column 25 lines 14-19") able to be connected to the computer and including a memory able to be accessed on reading and writing by said computer(see column 10 lines 21-54 and column 25 lines 44-50 and column 26 lines 26-35) said memory containing information relating to an access code the operator is to transmit to the computer so as to be able to use the method and to a credit allocated to the user, said memory further containing identification information of the authorized user(see column 28 lines 31-36 and 51-56) said identification information being allocated at the moment of purchasing the circuit or even downloaded (see column 28 lines 31-36 and 51-56 column 10 lines 21-54 and column 25 lines 44-50 and column 26 lines 26-35).

Otsuka fail to explicitly teach for each addressee, the setting up of an identification information sequence including the identification data of the addressee and each document to be sent to it, the coding of the identification information sequences respectively in the form of dot matrixes whose number and position in each matrix indicate the value and position in the sequence of each information unit composing the identification information

sequence the formatting and customization of the documents for each addressee including the insertion of the identification matrix of the addressee and the document in the portion of the document to be sent back by the addressee, the transmission by the system of the customized documents to the corresponding addressees.

However Hidding discloses for each addressee, the setting up of an identification information (i. e, name, zip code or client number") sequence including the identification data ("i. e, identification codes") of the addressee and each document("i. e, enclosure codes") to be sent to it. (see column 5 lines 25-40) the coding of the identification information sequences respectively in the form of dot matrixes whose number and position in each matrix indicate the value and position in the sequence of each information unit composing the identification information sequence. (see 5 lines 24-32) the formatting and customization ("i. e, merging or adding") of the documents for each addressee .(see column 5 lines 39-40) including the insertion of the identification matrix of the addressee and the document in the portion of the document .(see column 5 lines 1-40) to be sent back by the addressee, the transmission by the system of the customized documents to the corresponding addressees.(see column 5 lines 1-45).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Otsuka to include for each addressee, the setting up of an identification information sequence including the identification data of the addressee and each document to be sent to it, the coding of the identification information sequences respectively in the form of dot matrixes whose number and position in each matrix indicate the value and position in the sequence of each information unit composing the identification information sequence the formatting and customization of the documents for each addressee including the insertion of the identification matrix of the addressee and the document in the portion of the document to be sent back by the addressee, the transmission by the system of the customized documents to the corresponding addressees taught by Hidding in order to monitor system usage.

Otsuka and Hidding fail to explicitly teach the receiving by the system of the documents returned by the addressees, the reading and decoding of the identification matrixes featured on the documents received and the processing of said documents in

association with the read and decoded identification data and the documenting by the computer of the credit allocated to the user at the time of each use according to the number of edited matrix codes the "taking into account" of the using up of the credit contained in memory and on the basis of this taking into account prohibiting any subsequent use of the method.

However Wolf discloses once the desired documents have been obtain, gateway creates an image of each documents for transmission to the user processing. In one embodiment, gateway creates images by parsing, formatting and rendering the documents. The parsing of the documents, as well as formatting and rendering of the parsed documents, includes the conversion of document identifiers/locators associated with the retrieved documents to a machine readable code (e.g., bar code, digital paper, etc.) to be included in the images faxed to the user (to enable user selection of additional documents). Rendering is necessary for most documents to convert the data from ASCII to a raster bitmap, the protocol used by fax machines (and other marking engines) and then the processing logic of gateway searches the documents for circled regions (non-painted regions) based on the pixel color until the circled regions are obtained. Once located, the information in the circled regions is extracted and the present invention may also allow the user using fax machine to publish documents on the Web. FIG. 7 illustrates the process of the present invention for publishing a document on the Web. Referring to FIG. 7, in order to publish documents on the Web, a user initially obtains a hard copy of the documents to be published processing. In one embodiment, the user prints a copy of the document or receives the document from another source. The user then faxes the hard copy to a gateway server processing. In one embodiment, gateway also acts as the gateway server.(see column 6 lines 38-53 and column 7 lines 5-9 and column 7 lines 29-39).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Otsuka and Hidding to include receiving by the system of the documents returned by the addressees, the reading and decoding of the identification matrixes featured on the documents received and the processing of said documents in association with the read and decoded identification data and the

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documenting by the computer of the credit allocated to the user at the time of each use according to the number of edited matrix codes the "taking into account" of the using up of the credit contained in memory and on the basis of this taking into account prohibiting any subsequent use of the method taught by Wolf in order to monitor system usage.

As per claim 4, Otsuka discloses wherein the credit contained in said memory can be downloaded.

As per claim 7, Otsuka discloses wherein said electronic circuit is connected to a marked series port of the computer. (see column 28 lines 31-36 and 51-56 column 10 lines 21-54 and column 25 lines 44-50 and column 26 lines 26-35).

As per claim 8, Otsuka discloses wherein the identification information sequences to be coded contain duplicated identification information associated with at least one check sum. (see column 28 lines 31-36 and 51-56 column 10 lines 21-54 and column 25 lines 44-50 and column 26 lines 26-35).

As per claim 9, Otsuka discloses wherein the processing of document portions received include the reading and storage of information featured in these document portions in association with the read and decoded identification data. (see column 28 lines 31-36 and 51-56 column 10 lines 21-54 and column 25 lines 44-50 and column 26 lines 26-35).

As per claim 10, Otsuka discloses wherein the document portions transmitted by the addressees include boxes to be ticked, the method further including; the identification of the boxes ticked and not ticked by the addressee. (see column 28 lines 31-36 and 51-56 column 10 lines 21-54 and column 25 lines 44-50 and column 26 lines 26-35).

As per claim 11, Otsuka discloses wherein the coded information sequence coded in the form of dot matrixes and fixed on a document contains the identification information of the document. (see column 28 lines 31-36 and 51-56 column 10 lines 21-54 and column 25 lines 44-50 and column 26 lines 26-35).

As per claim 12, Otsuka discloses wherein the document sent to each addressee includes several portions, the method including the insertion in each document portion of an identification matrix obtained by the coding of an identification information sequence of

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the addressee, the document and the document portion. (see column 28 lines 31-36 and 51-56 column 10 lines 21-54 and column 25 lines 44-50 and column 26 lines 26-35).

As per claim 13, Otsuka discloses wherein the documents are sent by mail from the processing system to the addressees. (see column 28 lines 31-36 and 51-56 column 10 lines 21-54 and column 25 lines 44-50 and column 26 lines 26-35).

As per claim 14, Otsuka discloses wherein the documents are sent by fax from the processing system to the addressees. (see column 28 lines 31-36 and 51-56 column 10 lines 21-54 and column 25 lines 44-50 and column 26 lines 26-35).

As per claim 15, Otsuka discloses wherein the documents are sent by electronic messaging from the processing system to the addressees. (see column 28 lines 31-36 and 51-56 column 10 lines 21-54 and column 25 lines 44-50 and column 26 lines 26-35).

As per claim 17, Otsuka discloses wherein it further includes the updating of the data base with the information provided in the document portions transmitted by the addressees by indicating if appropriate the addressees who have not received the document sent to them because the address used is erroneous. (see column 28 lines 31-36 and 51-56 column 10 lines 21-54 and column 25 lines 44-50 and column 26 lines 26-35).

### Conclusion

#### RESPONSE TO ARGUMENTS

4. Applicant's arguments filed on 07/07/2005 have been fully considered but they are moot in view of new grounds of rejections.

5. • **Claim limitations that employ phrases of the type "Able to be, so as to be Able, Able to be connected, "At the time of" prohibiting any subsequent use of the method" and on the basis of taking into account"** are typical of claim limitations which may not distinguish over prior art. It has been held that the recitation that an element is **"At the time of" prohibiting any subsequent use of the method" and on the basis of taking into account"** performing a function is not a positive limitation but only requires the ability to so perform.

6. In response to Applicant's arguments that the Examiner failed to make a prime

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facie case of obviousness, the Examiner discloses what was stated in the office action. It would have been obvious to one of ordinary skill in the art at the time the invention was made that these functions are common in the art and are accomplished prior to registration regardless if one or two users are requesting registration, because only registered users are allowed access to the system. The benefit would have been to have users who can be identified accessing the system. In response to applicant's argument that Hartcock is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the primary reference, LaDue clearly teaches means and steps for effecting an electronic funds transfer (EFT) which is a financial transaction. Furthermore, the Examiner asserts that the date and time of occurrence of a financial transaction is usually timestamped onto a receipt or onto the financial document itself. In a global positioning system, it is also well known in the art to time stamp the occurrence of an event with/without the location of the occurred event/activity. The Examiner has turned to Hartcock to show this well known teaching. It is clearly noted that Hartcock clearly teaches a the synchronization of messages in a global positioning system. The EFT of LaDue is somewhat a message showing a receipt or an electronic transaction without a time stamped therein. Thus one of ordinary skill in the art would have been motivated to turn to the GPS art to denote such a teaching of a time stamp in the transmission of a message. Thus, LaDue and Hartcock are analogous art in the manner that both references attempt to solve the same problem by referencing a time stamp in a particular transaction or receipt or message.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR



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1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

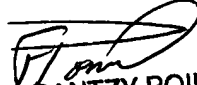
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

April 7, 2006

  
FRANTZY POINVIL  
PRIMARY EXAMINER  
*All 3628*